

Relative claim terminology is not *per se* indefinite. Rather, the pertinent inquiry is whether the claims "set out and circumscribe a particular subject matter with a **reasonable** degree of clarity and particularity" when considered in light of the application disclosure, the prior art, and the interpretation that would be given to the claims by one having an ordinary level of skill in the art. MPEP § 2173.02 (*emphasis added*).

In this case, the specification itself describes carrying out the inventive methodology using "spray equipment capable of producing tight, well-defined spray patterns..." P. 20, line 70. In this context (i.e., in the context of spray equipment), Applicant submits, one of ordinary skill in the art would readily understand the terms "tight" and "well-defined" to have the following ordinary dictionary meanings, respectively: "Set close together" (from Webster's New American Dictionary, p. 538 (Merriam-Webster, Inc. 1995)); and "having clearly distinguishable limits or boundaries" (*id.* at p. 597). These meanings, Applicant submits, provide the claim with the **reasonable** degree of clarity and particularity required by the statute.¹

Pending claims 33-47 also stand rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite, it being the examiner's position that the phrase "rapid cure times" is a relative term. Without accepting the propriety of the rejection, Applicant proposes to substitute the phrase "cures substantially instantaneously" in independent claim 33.

Claims 33-35, 37-41, 43, 45 and 47 stand rejected under 35 U.S.C. Section 102(e)

¹ In addition to the foregoing, Applicant notes that the examiner himself implicitly concedes the reasonable clarity and precision of the objected-to claim terminology in rejecting claim 1. Specifically, the examiner concedes that application of the claimed coating "in a tight, well-defined manner would have been obvious at the time the invention was made to a person having ordinary skill in the art." Official Action, p. 5.

as being anticipated by Primeaux, U.S. Pat. No. 5,962,618 ("the '618 patent"). Applicant respectfully disagrees.

The invention of the rejected claims comprehends a method for attenuating vibration transmitted through a passenger vehicle to the interior passenger cabin thereof, comprising the steps of: Providing at least one body component of a passenger vehicle; providing a substantially organic material consisting essentially of a liquid mixture of a first component and a second component; and applying the liquid mixture of the substantially organic material to the at least one body component in a manner sufficient so that, upon curing thereof, the substantially organic material attenuates vibration of the at least one body component.

In sharp contrast to the foregoing, the Primeaux '618 reference discloses a durable spray lining system for railway hopper cars. That Primeaux '618 is so limited is manifest from the specification, describes several applications of a spray lining system, **all of which** are limited to railway hopper cars such as used in the transportation of polystyrene beads and other materials.

Despite these clear limitations of the Primeaux reference, the examiner submits that that patent "reads on rail cars that may carry passengers." Official Action, p. 3. In response to this *unsupported assertion*, Applicant submits herewith the Declaration of Dudley J. Primeaux, II, one of the named inventor of the '618 patent, attesting to the fact that the '618 patent does **not** teach application of a polyurea spray lining to passenger vehicles. *See, e.g., Declaration of Dudley J. Primeaux, II, ¶ 4* Indeed, Mr. Primeaux

attests that such utility was unknown to him prior to his knowledge of the invention disclosed in the instant application. *Id* at ¶ 7.

Even accepting, *arguendo*, the examiner's reading of the Primeaux '618 reference as to the composition disclosed therein (which Applicant does not), it is thus abundantly clear from the record evidence that that patent simply does **not** teach the instantly claimed use.

Pending claims 1-11, 13-20, 22-29, 36, 42, 44, and 46 stand rejected under 35 U.S.C. Section 103(a) as being unpatentably obvious over Primeaux '618 patent. Applicant continues to disagree with the rejection.

The instant invention is predicated, at least in part, upon the unexpected discovery that materials such as claimed may be used to damp vibration of a substrate, including such vibration as may otherwise be transmitted through a passenger vehicle to the interior passenger cabin thereof (*see* claims 33-47). Accordingly, independent claims 1, 13, 20, and 24 all recite ***a method for damping vibration of a substrate*** wherein a liquid material is applied to a substrate in a manner which produces a tight, well-defined application pattern, and wherein the material adheres to the substrate in a manner which ***attenuates vibration, noise and harshness transmitted through the substrate***.

Even accepting, for argument's sake, the examiner's assertion that the instantly-claimed composition is identical to that disclosed in Primeaux '618, the method claims at issue are clearly directed to a new use, rather than simply a property of an old use (i.e., lining railway hopper cars). As indicated, Primeaux '618 teaches lining railway hopper cars. Applicant, on the other hand, has surprisingly discovered that the instantly-claimed

compositions may be put to the new use of attenuating the vibration of a substrate. These utilities are *not* the same.

Because the use of Applicant's invention is truly new, it is therefore improper for the examiner to rely on the asserted inherency of a vibration attenuating property of the compound disclosed in Primeaux '618 in making the obviousness rejection. As the court stated in In re Shetty, "[i]nherency is immaterial if one of ordinary skill would not recognize or appreciate the inherent result." 195 USPQ 753 (CCPA 1977); *see also* In re Spormann, 150 USPQ 449 (CCPA 1966). Here, the suggestion that one of ordinary skill would have, at the time of Applicant's invention, appreciated the vibration attenuating utility of freight car *lining* of Primeaux is untenable in the face of Mr. Pimeaux's own declaration that that invention of the '618 patent is applied in a passengerless environment.

In view of the above arguments, Applicant respectfully submits that the rejections of the remaining dependent claims, including claims 21 and 30-32 over the combination of Primeaux '618 in view of Xiao et al., are rendered moot. This fact notwithstanding, Applicant notes that the art of record, taken alone or in any permissible combination, fails to either anticipate or render obvious the invention of these claims. Should the examiner maintain the rejections to the claims, Applicant reserves the right to place the claims in allowable form, argue the patentability thereof, and/or appeal such rejection.

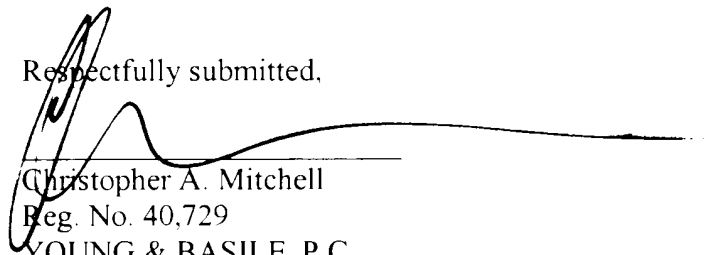
Finally, the pending claims 1-32 stand rejected under the judicially created doctrine of obviousness-type double-patenting. Applicant acknowledges the rejection.

but proposes to defer submission of a terminal disclaimer pending resolution of the ultimate issue of patentability of the affected claims.

III. Conclusion

In view of the foregoing, Applicant submits that the claims are in condition for immediate allowance. Of course, the examiner is invited to contact Applicant's undersigned counsel at (734) 662-0270 if he should have any questions respecting this paper, or if a telephonic interview might otherwise expedite the prosecution of this case.

Respectfully submitted,



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